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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,145	02/17/2004	John S. Erickson	P0935	6057

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DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

EXAMINER
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CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

MAIL DATE	DELIVERY MODE
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07/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/781,145

Applicant(s)

ERICKSON, JOHN S.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 8-12 and 14 are pending in the instant application and have been examined.

#### ***Response to Arguments***

2. Applicant's arguments filed May 7, 2007 have been fully considered but they are not persuasive.

The Applicant argues that the rejection of claim 1 under 35 U.S.C. Sec. 103(a) as unpatentable over Shostak US 5,694,608 and Pisello US 5,495,607 is improper.

The Applicant asserts that Pisello fails to teach the claimed feature of a "drag-and-drop" function being not permitted as per a set of usage rights received at a user device. The Applicant argues in essence that Pisello fails to teach such a feature since in the system of Pisello, such a drag-and-drop function may alternatively either be allowed, or delayed until a later time. The Examiner counters that the system of Pisello does teach the feature of not allowing a "drag-and-drop" request to be executed. In the cited passages of Pisello, the requested drag and drop action is stopped until the user grants permission. The Examiner maintains that this reads on the recited claim limitation.

The Applicant asserts that Shostak fails to teach the feature of receiving a request and checking an initial set of data representing usage rights. The Examiner maintains that the cited passages of Shostak do indeed teach these features. This feature is taught in the cited passages, and additionally for example, in col. 23 lines 1-

29 where the evaluation of a stored document is taught. It is inherent to the system of Shostak that upon opening a stored document, a permissions set such as a "document lock" will be evaluated upon request to open.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shostak, 5,694,608, and Pisello et al., US 5,495,607.

As for claims 8 and 11, Shostak teaches a method of controlling use of a content object that includes text (abstract), the method including; receiving data representing the object at a user device (fig. 2 element 260: User Interface, col. 8 lines 49-51, col. 9 lines 5-10); receiving at the user device an initial set of data representing usage rights associated with said object (col. 15 lines 55-67); the initial set of data defining a first set of rights that are permitted and a second set of rights that are not permitted (col. 15 lines 55-67); and upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed (col. 15, lines 55-67). Shostak does not teach that a drag

and drop function is among those that are not permitted. However Pisello teaches a step wherein the ability to utilize a drag-and-drop operation is dependent on evaluation of permission data associated with the content data (col. 18 lines 47-63). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these features into the method of Shostak. It would be desirable to do so since this would allow greater system control over end user content transfer. Motive to make this combination is found in Shostak, col. 2 lines 25-39 where the need for an efficient file database user interface is discussed.

As for claims 9 and 10, the combination of Shostak and Pisello does not teach that either a modify, a printing, or a saving function are among those that are not permitted. Yet Official Notice may be taken that such limitations on usage rights are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the combination of Shostak and Pisello. It would have been desirable to do so as this would allow greater control over the end-user's ability to alter or distribute the digital work.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shostak as applied to claim 8 above, and Earnest, US 4,888,798

As for claim 12, Earnest teaches the features of the claim that Shostak fails to, namely, engaging with a remote server to obtain revised data representing usage rights (col. 3 lines 10-15). Therefore it would have been obvious to one of ordinary skill in the

art at the time of the invention to incorporate this feature into the method of Shostak. It would be desirable to do so since this would allow a user to undertake a file transfer in situations where a permissions database does not permit such a function immediately as in Shostak.

***Allowable Subject Matter***

5. Claim 14 is allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field does not teach the combination of features set forth in claim 14, particularly including the steps of: when there is a blocked e-mail transmission, querying a remote server to determine criteria for transmission, and if the criteria is met, receiving an updated set of data defining a second set of rights that are permitted, the second set of rights including transmission rights.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
/Paul E. Callahan

February 1, 2007.

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER